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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,877	04/04/2001	Takafumi Soramoto	P 280041 VN-0071US	1841
909	7590	05/25/2006	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP			GARG, YOGESH C	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	
			3625	

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/824,877

Applicant(s)

SORAMOTO ET AL.

Examiner

Yogesh C. Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 37 and 38 is/are pending in the application.
- 4a) Of the above claim(s) 4-9, 15-20, 23-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37 and 38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/10/2006 has been entered.

### ***Response to Amendment***

2. Applicant's amendment received on 3/10/2006 is acknowledged and entered. Claims 1-3, 10-14, 21-22, and 36 are canceled. Claims 4-9, 15-20, and 23-35 are previously withdrawn to Non-elected invention (s) in the applicant's response filed on 3/7/2005. New claims 37-38 are added. Currently claims 37-38 are pending for examination

### ***Response to Arguments***

3.1. Applicant's arguments filed on 3/10/2006 (see Remarks, pages 10-13) have been considered but are moot in view of the new ground(s) of rejection necessitated due to submission of new claims 37-38.

4. Note 1: Claim 37 is a system (apparatus) claim directed to structural elements of a server, that is a user database, a member store database, a deal database, a merchandise database and a communication interface. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d

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844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus in rejecting system claim 37 emphasis has been given that the prior art teaches the the structural limitations that is a user database, a member store database, a deal database, a merchandise database and a communication interface and not the terms of the intended use/functionality, that is using the server for a compensation-granting portal site on the Internet.

Note 2: Claim 38 is a method claim and its preamble recites an intended use of the method for granting compensation for a deal performed on the Internet. This recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant application the body of the claim comprising the steps of storing information of user/member store/deal/merchandise and transmitting the processed results can stand alone without depending upon the intended use, granting compensation for a deal performed on the Internet, recited in the preamble of the claim.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 37-38 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory Subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added), per *State Street test*.

Claim 37 recites a server comprising different types of databases and a communication interface and the server processes these databases according to programs stored in a CPU, ROM, and a RAM and transmits some processed results to Internet. It is not clear if the claimed invention is a "new and useful process, machine, or any new and useful improvement thereof". A server could be a computer or program running on a network with several databases and processing the information from these databases and transmitting processed results. These transmitted results could be some numbers or data without representing a real world specific practical value and therefore the claim does not qualify the test that it is "useful ", and "concrete" and " tangible".

Claim 38 recites a process comprising storing different types of data and transmitting some processed results to Internet. It is not clear if the claimed invention is a "new and useful process, machine, or any new and useful improvement thereof". The processed transmitted results could be some numbers or mere data without representing a real world specific practical value and therefore the claim does not qualify the test that it is "useful ", and "concrete" and " tangible".

The Court of Appeals for the Federal Circuit issued opinions in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999). These decisions explained that, to be eligible for patent protection, the claimed invention as a

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whole must accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601 02. To satisfy section 101 requirements, the claim must be for a practical application of the § 101 judicial exception, which can be identified in various ways: (a) The claimed invention “transforms” an article or physical object to a different state or thing. (b) The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

The USPTO's official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. See MPEP § 2107.

The tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application”).

For an invention to produce a “concrete” result, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is “irreproducible” claim should be rejected under section 101). The opposite of “concrete” is unrepeatable or unpredictable.

There is no useful, concrete and tangible result produced from claims 37 and 38 and therefore do not satisfy 35 USC 101.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 37-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 37 and 38 recite the limitation "the processed results" in line 17 of claim 37 and in line 14 of claim 38. There is insufficient antecedent basis for this limitation in the claim. Also, it is unclear how the results are processed.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 37-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al (US Patent 6,249,772 B1), hereinafter, Walker.

Regarding claim 37, Walker discloses a server for a compensation-granting portal site on the Internet having a first URL, and connecting to a plurality of other servers through the Internet (Note: Walker's central controller system "110" in Fig.1 represents the claimed server ), the server comprising:

a user database configured to store information of each user corresponding to the user ID (see Fig.2, " 220-customer database", and col.12, lines 22-65);

a member store database configured to store information of each member store

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corresponding to the member store ID (see Fig.2-" 218 POS Controller Database" and col.12, lines 22-65. POS controller database stores information about various POS stores );

a deal database configured to store information of each deal corresponding to the member store ID (see Fig.2-" 222 Transaction Database" and col.12, lines 22-65.);

an objected merchandise database configured to store information of each merchandise corresponding to the merchandise ID (see Fig.2-" 216 Merchandise Database and col.12, lines 22-65". ); and

a communication interface configured to grant communication access to a user via said URL (see Fig.2 and col.12, lines 22-65. Note: Processor 202 provides communication interface to grant communication access to a user via a communication link 208 and this can be done by using the URL of the web site/portal site comprising the said server );

wherein said server for a compensation-granting portal site processes said user database, said member store database, said deal database, and said objected merchandise database according to the program stored in a CPU, a ROM, and a RAM, then, transmits the processed results to said Internet through said communication interface ( see at least col.9, line 57-col.10. line 9 and Figs.1-2 and col.12, lines 22-65) .

Regarding claim 38, all the limitations are closely parallel to the limitations of claim 37 and is therefore analyzed and rejected on the same basis.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



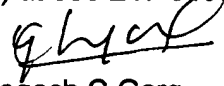
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US Patent 6,108,639 to Walker et al. discloses a server (see Central Controller –200 in Fig.1) which comprises a user database (see Fig.2, “ 300”), a member store database (see Fig.2, “ 400” ), a deal database (Fig.2, “ 700”), a merchandise database (Fig.2, “ 800”) and communication interface to grant communication access to a user via said first URL (see Fig.2).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
November 7, 2005